

REMARKS

Claims 1-12, 15-18, 20-22, and 24-26 are currently pending in the subject application and are presently under consideration. Claims 1, 6-10, 12, 15-18, 20-22, and 24-26 have been amended as shown on pages 3-5 of the Reply. Claims 13, 14, 19, and 23 have been cancelled.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Objection to Information Disclosure Statement

The information disclosure statement filed May 21, 2004 stands objected to in view of the Bederson *et al.* not being legible. A copy of Bederson *et al.* is being submitted with this Reply. Accordingly, this objection should be withdrawn.

II. Objection to Priority Claim

Applicants' claim for domestic priority under 35 U.S.C. §119(e) stands objected to under the incorrect contention that the parent application upon which priority is claimed fails to provide adequate support under 35 U.S.C. §112 for claims 3-4, 11, 13-14, and 19. The Examiner asserts that the features recited in these claims are not mentioned in the originally filed case, not even in the claims. Withdrawal of this objection is requested for at least the following reasons.

Claims 13, 14, and 19 have been cancelled. Applicants' representative submits that the specification in the parent application provides all necessary support for the limitations of the remaining claims. See sections V through VIII below for a detailed discussion supporting this contention.

B. Also, the Examiner incorrectly asserts that applicants were not in possession of the claimed subject matter at the time the parent case was filed because the original application does not have any claims directed to car navigation systems or the like, only the one sentence suggesting it. It is respectfully requested that this objection to the priority claim be withdrawn for the following reasons. The specification in the parent application provides all necessary support for the limitations of the subject claims, and it is not a requirement that the parent application include claims that overlap with progeny cases. Applicants were in possession of the claimed subject matter at the time the parent case was filed. See sections V through VIII below for a detailed discussion supporting this contention.

C. Also, the Examiner contends the case as filed is not a proper divisional because the claims as originally filed with the divisional were not present or supported in the parent application. Therefore, designating the case as a DIV is improper. The proper status of this case should be a continuation (CON) with the odometer, speedometer, and other similar claims filed as a CIP.

It is respectfully requested that this objection to the priority claim be withdrawn for the following reasons. Per MPEP §201.06, "A later application for an independent or distinct invention, carved out of a pending application and disclosing and claiming only *subject matter disclosed in the earlier or parent application*, is known as a divisional application or "division." Applicants' representative contends that the specification in the parent application provides all of the necessary support for the limitations recited in the subject claims that are directed to an invention that is different than that claimed in the parent. As such, the subject application is a properly filed divisional of the parent application. See sections V through VIII below for further discussion supporting this contention. This objection should be withdrawn.

III. Objection to Specification

Applicants are required to amend the specification as per 35 U.S.C. §112, sixth paragraph to recite which means are being used to implement the method of claim 24. It has been clearly established that if applicants wish to have the protection of means-plus-function language, applicants must clearly set forth in the specification which means are being used to perform which step.

It is respectfully requested that this objection to the specification be withdrawn for the following reasons. In accordance with 35 U.S.C. §112, "An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding **structure, material, or acts described in the specification** and equivalents thereof." As such each element of claim 24 is supported in the specification. For example, the limitations "means for displaying a map to a user in a vehicle" at page, lines 20-21 which discloses a display structure, "means for determining speed information related to the vehicle" at page 15, lines 21-23 which discloses an act of determining driver speed which is directly related to vehicle speed, and "means for adjusting scale of the map based at least in part

on speed information related to the vehicle” page 19, line 18-page 20, line 12 which discloses the acts of relating input to scale. See sections V through VIII below for a detailed discussion supporting this contention. Accordingly, this objection should be withdrawn.

IV. Definitions

The term "interval" in claims 13 and 14 is being interpreted by the Examiner as meaning a) a certain speed range of the vehicle or b) a certain distance traveled by the vehicle in a certain time (e.g. the dictionary definition for speed). The Examiner requests that if applicants wish to dispute this, applicants must point out where in the specification there is support for an alternate definition. Applicants' representative submits that "interval" can also be interpreted as "the interval traveled by a gas pedal from its starting position when force is exerted on the gas pedal by a user." It was well known in the art at the time of the invention that a driver exerting force on a gas pedal will result in the gas pedal moving from its initial position to a new position. Accordingly, this definition is also supported in the specification. (*See e.g.*, page 14, lines 14-20 and page 15, lines 22-23)

V. Rejection of Claims 1-26 Under 35 U.S.C §112

Claims 1-26 stand rejected under 35 U.S.C §112, first paragraph, because the specification, while being enabling for displaying a map, does not reasonably provide enablement for a component that receives speed information relating to a movement of a vehicle.

A. The Examiner asserts that the specification never uses the term 'vehicle' outside of the claims, and that there is only one sentence in the entire specification that could reasonably be construed as providing enablement for this embodiment, and that is found on page 16, lines 20-24. Applicants' representative contends that it was well known in the art at the time of the invention that a "car" is a type of "vehicle" and as such the term "car" as employed in the cited section supports the use of the term "vehicle" in the claims.

B. The Examiner also incorrectly asserts that the specification supports only the definition where speed is defined in terms of an input by the user. Contrary to these assertions, the specification provides all necessary support for the limitations recited in claim 1.

In particular, independent claim 1 recites *a navigation system comprising: a display for displaying an area of a map; a component that receives speed information relating to movement of a vehicle; and a navigation component that modifies a scale of the map display area as a function of the speed information.* The specification clearly discloses a computer system comprised of minimally an input device, a program, and a display (*See e.g.*, page 21, line 17 – page 22, line 12, Figure 8.) where the program receives an input relating to speed and/or direction of movement of the user directed input device that is used to adjust scale or speed of navigation on the display.

Page 15, lines 21-23 along with the other details of the invention provided in the specification and drawings are fully enabling to those skilled in the art for this embodiment of the invention. Specifically, it was well known in the art at the time of this invention that automobiles contain one or more connected computers and sensors along with an integrated or optionally installed navigation system. It was also well known in the art at the time of the invention that when a user applies force to the gas pedal to drive a vehicle that sensors are initiated that provide speed, tachometer, and odometer readings to the computer. This information is readily available to the navigation system as input. A user applying force to a gas pedal, which is a lever (*See e.g.*, page 3, lines 16-18), is analogous to a user applying force to a joystick or a mouse to initiate sensors in the input device which in turn provides an input to the computer. The navigation system as was well known in the art at the time of the invention is a computer system that can be either be part of the vehicle's computer system or connect to the vehicles computer system, which is supported by the specifications disclosure of operating environments that include multifunction computer systems or networked computer systems (*See e.g.*, page 6, line 24 – page 10, line 11, Fig 1). The navigation system takes the speed information input and adjusts the scale or speed of navigation on the navigation system display. The specification clearly discloses that content in the display will adjusted for speed of navigation or scale. (*See e.g.* page 10, line 20 – page 11, line 21. Moreover, the specification identifies that content can include maps. (*See, e.g.*, page 11, line 22 – page 12, line 6) It was

well known in the art at the time of the invention that navigation systems include user displays and that they contain road maps (See e.g., page 12, lines 12-14 and page 15, lines 20-21).

C. The Examiner further argues that various dependent claims are not enabled for example claims 4, 5 and 11 since there is no mention of a speedometer, odometer, aerial map or topographic map in the specification, or the relationship between speed of a vehicle and the scale of the map per se. Applicants' representative contends that at the time of the invention it was well known in the art that vehicles contain a speedometer and odometer, as those devices are legally required on cars. Furthermore, it was also well known in the art at the time of the invention that road maps may contain topographical information or aerial views.

The Examiner is reminded that the standard for enablement is that the invention be sufficiently described so that one skilled in the art would be able to practice the claimed invention without undue experimentation. Accordingly, it is clear that there is no requirement to explicitly call out in laundry list fashion features of a claimed item within the specification where such features are inherently present within the item and well known to those skilled in the art let alone lay individuals.

In view of at least the foregoing discussion, applicants' representative respectfully submits that the specification is fully enabling for the limitations recited in claims 1-12, 15-18, and 20-26. Accordingly, this rejection should be withdrawn.

VI. Rejection of Claims 1-26 Under 35 U.S.C §112

Claims 1-26 stand rejected under 35 U.S.C §112, first paragraph, as requiring undue experimentation as per *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

A. Applicants' representative contends that the engineering required to produce the speed information input (speedometer tachometer, and odometer) in a vehicle was well established art at the time of the invention and that the necessary speed input information is readily available in the cars computer system. As such, the input data merely needs to be read from memory by the navigation system, as a component of the vehicles computer system or as a networked computer device. The specification fully discloses how a computerized system employs the invention. A navigation system is a type of computer system.

B. The Office Action attempts to limit the scope of the invention to document display. However, the specification clearly discloses that embodiments of the invention can include content display of varying forms, including maps. (See. e.g., page 11, line 22 – page 12, line 6) Applicants' representative contends that those skilled in the art, in the case of a vehicle navigation system are vehicle navigation system engineers. Vehicle navigation system engineers would be familiar with the vehicle's computer system and navigation system displays.

C. The Examiner asserts that using the gas pedal as a user interface for controlling the speed and/or scaling of the map (see 15:21-24), while perhaps not being inoperative, is impracticable. The Examiner is reminded that the legal standard for patentability is that the invention be new, useful, and not obvious, which the claimed invention clearly meets – there is no legal basis for the Examiner's opinion as to how practical the invention may or may not be as being a standard for patentability.

As discussed supra in section (V)(B), the use of a gas pedal as the user input device is fully supported by the specification. As to the usefulness of such an input device, the specification clearly discloses that the relationship between speed of display navigation and scale of display are tied by a function which can provide for mitigation of any extreme variation in scaling. See e.g. page 16, line 4 – page 19, line 4). For example, if the speed of the vehicle is tied to the speed of the display navigation, an exponential or logarithmic function can be employed that results in little change of display scale at lower speed and larger scale changes at higher speed.

Accordingly, applicants' representative respectfully submits that the specification is fully enabling for the limitations recited in claims 1-12, 15-18 and 20-26 and does not require undue experimentation. Therefore, it is respectfully requested that this rejection should be withdrawn.

VII. Rejection of Claims 1-26 Under 35 U.S.C §112

Claims 1-26 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

A. Claims 4-5 stand rejected because there is no mention of a speedometer, odometer, or the like in the specification. As discussed above, applicants' representative contends that at the time of the invention it was well known in the art that vehicles contain a speedometer and odometer, as those devices are legally required on cars.

B. Claim 11 stands rejected because there is no mention of a topographical map and/or an aerial map. Contrary to assertions in the Office Action, the specification specifically mentions a map with all roads and towns, which is a road map. (See e.g., page 12, lines 12-14) Furthermore, it was also well known in the art at the time of the invention that road maps may contain topographical information or aerial views.

C. The rejections of claims 13, 14 and 19 are moot in view of the cancellation of these claims.

For at least the foregoing reasons, withdrawal of this rejection is requested.

VIII. Rejection of Claims 1-26 Under 35 U.S.C §112

Claims 1-26 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Specifically, in claims 24-26 applicants have not clearly set forth what means are being used to execute which steps of the recited method as required in order to seek protection of the claims under 35 U.S.C. 112, sixth paragraph.

As noted supra with in section III, each element of claim 24 is supported in the specification. For example, the limitations “means for displaying a map to a user in a vehicle” at page, lines 20-21 which discloses a display structure, “means for determining speed information related to the vehicle” at page 15, lines 21-23 which discloses an act of determining driver speed which is directly related to vehicle speed, and “means for adjusting scale of the map based at least in part on speed information related to the vehicle” page 19, line18-page 20, line 12 which discloses the acts of relating input to scale. See sections V through VIII below for a detailed discussion supporting this contention.

Claim 25 recites *means for selectively indicating the position the vehicle on the map area display*. The specification on discloses that in indicator can appear on the display that shows the relative position within the document that is currently displayed. (See e.g., page 14, line 21 – page 15, line 25, and Fig 5.) The document being displayed can be a map with the indicator

showing the position of the vehicle on the map.

Claims 1, 12, and 24 stands rejected for using the same word having different meanings within one claim, and thusly being indefinite.

The Office Action asserts that in the independent claims applicants have used the same term “speed” with two different meanings in the same claim. On the contrary, the parent and subject application use the term speed consistently as “rate of movement”. In the case of the input device, it is the rate of movement of the input device. Within the navigation system display, it is the rate of movement of the content within the display. These are both consistent usages of the term “speed.”

Accordingly, applicants’ representative respectfully submits that the specification is fully enabling for the limitations recited in claims 1-12, 15-18 and 20-26 and does not use the term “speed” inconsistently. Therefore, it is respectfully requested that this rejection should be withdrawn.

IX. Objection to Drawings

The drawings are objected to because they are not sufficient as they show none of the claimed subject matter. It is respectfully requested that this objection to the priority claim be withdrawn for the following reasons. The specification and drawings clearly provide support for the claimed subject matter as discussed *supra*. Consequently, it is respectfully requested that this objection should be withdrawn.

X. Rejection of Pending Claims Under 35 U.S.C. §103(a)

The pending claims (1-12, 15-18, 20-22, and 24-26) stand rejected under 35 U.S.C. §103(a) as being unpatentable over various references (Sievers *et al.* (US 6,163,752), Nakayama *et al.* (US 5,732,385), Sanderson *et al.* (US 6,279,906 B1), Pelin (US 3,618,240), Nimura (US 5,884,218), Boyer (US 6,445,397 B1), and Carpendale (Carpendale, M.S.T. "A Framework for Elastic Presentation Space." Ph.D. Thesis. March 1999)). Withdrawal of the rejections based on these references is respectfully requested for at least the following reasons.

Independent claims 1, 12, and 24 have been amended herein to recite that an *amount of text detail of the map area displayed to the user is modified as a function of the speed information wherein as speed of the vehicle increases the amount of text detail decreases, and as speed of the vehicle decreases the amount of text detail increases*. None of the cited references, alone or in combination teach or suggest such claimed features of applicants' invention. In particular, the cited art disclosed scaling of displayed maps as a function of speed, but they do not disclose varying the amount of text detail displayed as a function of speed. Thus, for example as speed is at a high level, a single word may be displayed that corresponds to a paragraph, and as the speed of the vehicle decreases the entire paragraph can be disclosed as described in the specification for example at page 13.

In view of at least the foregoing comments, withdrawal of the rejections under 35 U.S.C. §103(a) is requested.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP276USA].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN & TUROCY, LLP



Himanshu S. Amin

Reg. No. 40,894

AMIN & TUROCY, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731